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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
STORK, KYLE R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/625,300

Applicant(s)

HICKMAN ET AL.

Examiner

KYLE R. STORK

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6 and 10-41 is/are pending in the application.
- 4a) Of the above claim(s) 33-35 and 37-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 10-32 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

1. This non-final office action is in response to the RCE and the amendment filed 28 January 2008.
2. Claims 1, 5-6, and 10-41 are pending. Claims 2-4 and 7-9 are cancelled by the amendment. Claims 32-42 are newly added. Claims 1, 21, 27, and 31-42 are independent claims.

### ***Election/Restrictions***

3. Newly submitted claims 33-35 and 37-41 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

Claims 33-35 and 37-41 disclose facilitators, electronic signature delivery, communication systems, form filling, forms server, and form verification. These claims are not directed toward an electronic filing system, and are therefore restricted.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33-35 and 38-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 5-6, and 10-20 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant claims an "electronic document to be filed with said receiving agency server by said web server in a manner that said receiving agency computer believes that it is in direct communication with said client machine (claim 1, lines 10-12). The applicant's specification fails to disclose a receiving agency server believing that the server is in direct communication with a client machine.

Claims 5-6 and 10-20 are rejected based upon their dependence upon claim 1.

Claim 31 discloses the limitations substantially similar to those in claim 1. Claim 31 is similarly rejected.

6. Claims 1-20 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims an "electronic document to be filed with said receiving agency server by said web server in a manner that said receiving agency computer believes that it is in direct communication with said client machine (claim 1, lines 10-12).

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The applicant's specification fails to disclose a receiving agency server believing that the server is in direct communication with a client machine.

Claims 5-6 and 10-20 are rejected based upon their dependence upon claim 1.

Claim 31 discloses the limitations substantially similar to those in claim 1. Claim 31 is similarly rejected.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 5-6, 12-13 remain rejected and claims 14-15, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen et al. (US 6493722, filed 13

April 1999, hereafter Daleen) and further in view of Pearson (US 6023684, filed 1 October 1997).

As per independent claim 1, Daleen discloses an electronic filing system (column 4, lines 7-8; Figure 1, item 104: Here, the EFS is a database), wherein:

Documents are filed for further processing by a receiving agency associated with said receiving agency server in accordance with a procedure for which said receiving agency is in some manner responsible

A receiving agency server coupled to a wide area network (Figure 1, item 106)

Client machines coupled to a WAN that communicates to the receiving agency server (Figure 1, item 112)

Daleen fails to specifically disclose a web server coupled to a WAN that serves as an interface to the receiving agency server. However, Pearson shows the use of intermediate servers (Figure 2; columns 1-21). Pearson further indicates that one may employ a path such as a path from a client (Figure 2, items 26 or 28) to the web server (50) to the application server (56), allowing control and filtering of data flow. Pearson further discloses wherein the receiving agency server (Figure 2, item 48) is separate from the web server (Figure 2, item 50) and the agency computer believes it is in communication with a client machine (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Pearson with Daleen, since it would have allowed for filtering and control of data flow.

As per dependent claim 5, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen discloses a network is the Internet, which is a TCP/IP protocol network (column 1, lines 20-57).

As per dependent claim 6, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen discloses wherein the network is the Internet (column 1, lines 20-57).

As per dependent claim 12, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen integrates a billing system including an electronic filing system wherein a server transacts a financial transaction with the receiving agency on behalf of a client machine (Abstract).

As per dependent claim 13, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen further discloses providing a message to the user which constitutes an automated electronic filing system wherein the web server provides a portion of the electronic document in response to a selection from the client machine (Figure 5A, item 508).

As per dependent claims 14 and 15, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen further discloses wherein network machines are connected via a WAN (Figure 1).

As per independent claim 31, the applicant discloses the limitations substantially similar to those in claim 31, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein the filing is a trademark application, but the examiner takes official notice that filing of trademark application was notoriously well known in the

art at the time of the applicant's invention. Therefore, it would have been obvious to have applied Daleen and Pearson to trademark applications, thereby allowing for efficient filing of trademark applications.

As per independent claim 36, the applicant discloses the limitations similar to those in claim 31. Claim 36 is similarly rejected.

10. Claims 10-11 and 18-19 remain rejected and claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson and further in view of Blackwell, Jr. et al. (US 5857191, filed 8 July 1996, hereafter Blackwell).

As per dependent claim 10, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 11, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at



the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 16, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 17, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 18, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose encrypting communications over a network. However, Blackwell discloses encrypting communications over a network (columns 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's

invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

As per dependent claim 19, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose wherein communications between the client machine and the web server are subject to authentication. However, Blackwell discloses authentication (column 1, lines 38-40). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Blackwell with Daleen, since it would have provided secure communications over a network.

11. Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Daleen and Pearson and further in view of Lee, US 5347477, filed 2 March 1993).

As per dependent claim 20, Daleen and Pearson disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Daleen fails to specifically disclose partially automated form filling. However, Lee discloses partially automated form filling (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lee with Daleen, since it would have allowed a user to quickly and easily fill form data.

12. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe et al. (US 2001/0011250, filed 12 November 1998, hereafter Paltenghe) and further in view of Daleen.

As per independent claim 21, Paltenghe discloses storing data useful for populating an HTML based form, providing the form to a client machine coupled to a network, partially automated form filling with suitable data selected from data input from a client machine, verifying information of the form based upon stored heuristics and submitting the form to a receiving agency via a network (paragraph 0049; Figure 2).

Paltenghe fails to specifically disclose a web server coupled to the client. However, Daleen discloses a receiving agency server coupled to a wide area network (Figure 1, item 106). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Paltenghe, since it would have allowed a user submit form data to a receiving agency server (Daleen: Figure 1).

As per independent claim 27, the applicant discloses the limitations similar to those in claim 21. Claim 27 is similarly rejected.

13. Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe and Daleen and further in view of Brown.

As per dependent claim 22, Paltenghe and Daleen disclose the limitations similar to those in claim 21, and the same rejection is incorporated herein. Paltenghe fails to specifically disclose verifying information. Brown further discloses that the user name is obtained at the same time as the password, constituting a method for verifying information (column 3, lines 62-63). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with

Paltenghe, since it would have allowed for secure transmission based upon user identity.

As per independent claim 28, the applicant discloses the limitations similar to those in claim 22. Claim 28 is similarly rejected.

14. Claims 23, 25-26, and 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, and Brown and further in view of Holloway (US 5604802, filed 18 July 1994).

As per dependent claim 23, Paltenghe, Daleen, and Brown disclose the limitations similar to those in claim 22, and the same rejection is incorporated herein. Brown fails to specifically disclose obtaining an electronic signature. However, Holloway discloses use of an electronic signature (column 5, lines 35-55). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention since it would have allowed for secure information transactions.

As per dependent claim 25, Paltenghe, Daleen, and Brown disclose the limitations similar to those in claim 23, and the same rejection is incorporated herein. Brown fails to specifically disclose obtaining an electronic signature. However, Holloway discloses use of an electronic signature (column 5, lines 35-55). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention since it would have allowed for secure information transactions.

As per dependent claim 26, Paltenghe, Daleen, Brown, and Holloway disclose the limitations similar to those in claim 23, and the same rejection is incorporated

herein. Brown fails to specifically disclose the use of the TCP/IP protocol. However, Daleen discloses a network is the Internet, which is a TCP/IP protocol network (column 1, lines 20-57). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Brown, since it would have allowed for the utilization of a protocol standard to communicate data over a network.

As per independent claim 29, the applicant discloses the limitations substantially similar to those in claim 23. Claim 29 is similarly rejected.

15. Claims 24 and 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe, Daleen, Brown, and Holloway and further in view of Wiitala et al. (US 6122622, filed 18 February 1998).

As per dependent claim 24, Paltenghe, Daleen, and Brown, and Holloway disclose the limitations similar to those in claim 23, and the same rejection is incorporated herein. Brown fails to specifically disclose receiving a filing fee. However, Wiitala discloses receipt of a filing fee (Abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Wiitala with Brown, since it would have allowed a user to receive payment for services.

As per dependent claim 30, the applicant discloses the limitations substantially similar to those in claim 24. Claim 30 is similarly rejected.

### ***Response to Arguments***

16. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Although some rejections have been withdrawn in favor of new rejections, other rejections remain. The examiner will address the arguments pertaining to the claims that remain rejected.

The applicant argues that Daleen does not disclose a receiving agency server (page 11). The examiner does not entirely agree with this assertion. Daleen discloses transmitting data from a client to a server (column 4, lines 7-8; Figure 1). Regardless of the applicant's belief, Pearson discloses both a web server and a receiving agency server (Figure 2). Pearson is relied upon for disclosing both servers; therefore, this argument is not moot, as the Daleen-Pearson combination discloses the limitations.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kirk, "Washington State: First State to Pioneer Web Tax Filing and Payment," The Journal of Electronic Commerce, 1998.
- Yum et al., "An Utility Company's Experience On Electronic Filing System For Engineering Applications," IEE 2nd International Conference on Advances in Power Systems Control, Operation and Management, 1993.
- Hampton, "Expansion of Pilot of Electronic Filing of Trademark Applications," 25 September 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KYLE R. STORK whose telephone number is (571)272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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